

**Remarks**Summary of facts:

- 1) Provisional application, 60/023,280 was filed July 25, 1996, naming Anderson, Saito, Greenwood and Sun as Applicants.
- 2) Provisional application 60/023,280 consisted of one published article, Saito, et al., MCN, 6:280-292 (1995) (Saito) wherein Saito, Greenwood, Sun and Anderson are listed as Authors. (Publication date is August 22, 1995).
- 3) Provisional application 60/023,280 does not have any section entitled "Claimed Subject Matter"; its an article as stated in paragraph (2).
- 4) No Declaration/oath was filed for 60/023,280, therefore, none of the Applicants listed in paragraph (1) signed any documents in 60/023,280.
- 5) Sun, who as indicated in paragraph (1) above was listed in the transmittal as an Applicant, was not listed in the Response to Missing Parts indicating residences of Applicants, so in a Response to a Notice of Incomplete Response, the residence of Sun was forwarded to the PTO on January 10, 1997.
- 6) Provisional application 60/023,280 went abandoned during July of 1997, wherein there was still no Declaration/oath, no signatures by Applicants on any documents, and no Section of Claimed Subject Matter.
- 7) August 22, 1996, Utility application 08/701,278 was filed claiming priority to Provisional application 60/023,280, naming Anderson and Saito as inventors.
- 8) December 23, 1998, a Declaration under 37 CFR 1.132 in accordance with In re Katz, was submitted to the PTO, indicating that the work contributed by Greenwood

and Sun in the Saito MCN paper did not rise to the level of inventorship in Utility application 08/701,278.

9) The Advisory Action of April 12, 1999 in Utility application 08/701,278 states that the In re Katz declaration contradicts Provisional application 60/023,280 from which priority is claimed which "specifically states" that Greenwood and Sun are inventors, and therefore, the In re Katz "is not persuasive to obviate the 102(a) rejection" over Saito. The Advisory Action further states that the different inventive entities still exist. In conclusion, the Advisory proposes re-opening the abandoned provisional application to change the inventorship under Rule 1.48(e) to obviate the inconsistency in the In re Katz declaration.

Request for reconsideration:

Applicants respectfully request reconsideration of whether the Declaration under 37 CFR 1.132 in accordance with In re Katz submitted to the PTO on December 23, 1998 obviates the 102(a) rejection over Saito.

The In re Katz declaration specifically states that the work contributed by Greenwood and Sun in the Saito MCN paper did not rise to the level of inventorship in Utility application 08/701,278. Saito was published within one year of the Utility application as confirmed by a Declaration submitted December 23, 1998.

While there is no mention as to whether the contributions of Greenwood and Sun rise to the level of inventorship in Provisional application 60/023,280, technically, there is no claimed subject matter in Provisional application 60/023,280. Therefore, Applicants submit that an In re Katz would not be applicable to Provisional application

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60/023,280.

Similarly, since technically there is no claimed subject matter in the provisional application, a change of inventorship in the provisional application (even if not abandoned) seems inappropriate. In particular, it is unclear how we would address whether Greenwood and Sun invented any claimed subject matter in the provisional application when there is no claimed subject matter.

In any event, Applicants submit that there is no legal basis to require that the inventorship to an abandoned priority case and a pending case be the same in order to submit an In re Katz declaration to obviate art published within a year of both the priority and the pending case.

The 102(a) rejection is obviated by the In re Katz declaration which address the present claims and which addresses an article published within a year of the utility application. Therefore, the In re Katz declaration is properly applied to the present case.

Moreover, Applicants point out that the MPEP, Section 201.04, (enclosed again) in the discussion of 37 CFR 1.48(e) is applicable, and "is in context". In particular, MPEP, Section 201.04 is not directed toward priority *per se*, but is directed toward any situation where one might change inventorship in a provisional application. The language only mentions priority to indicate that the role of the provisional application (to serve as a priority document) is not effected by a change of inventorship, therefore, there is no reason to correct, or make consistent, inadvertent errors in inventorship.

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Furthermore, Applicants' counsel have spoken with the Petitions Division regarding the suggestion in the Advisory Action to re-open the abandoned provisional case under Rule 1.182 so that inventorship can be changed under Rule 1.48(e). The Petitions Division indicated that this is not necessary since there is no claimed subject matter in the provisional application.

Therefore, the only issue that seems to be remaining is simply an "inconsistency" in the record" due to an inadvertant error in an abandoned application with no claimed subject matter. Applicants submit that if one wanted to determine the inventorship of the claimed subject matter in utility 08/701,278, one would turn to 08/701,278, therefore no harm is done.

The In re Katz is applicable because Saito was published within a year of the utility application. Specifically, the declaration is directly applicable to the claimed subject matter without consideration of the priority document or inventorship therein. Therefore, in light of the foregoing, Applicants respectfully request that the present case be allowed.

Respectfully Submitted,

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## 201.04

## MANUAL OF PATENT EXAMINING PROCEDURE

inventor is not being improperly deleted from the application. Written consent of any assignee is not required for petitions filed under 37 CFR 1.48(b).

When any correction or change is effected, the file should be sent to the Application Division for revision of its records and the change should be noted on the original oath or declaration by writing in red ink in the left column "See Paper No. \_\_\_ for inventorship changes". See MPEP § 605.04(g).

## 37 CFR 1.48(c)

37 CFR 1.48(c) provides for the situation where a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application as filed. In such a situation, the nonprovisional application may be amended pursuant to 37 CFR 1.48(a) to add claims to the subject matter and also to name the correct inventors for the application. The claims would be added by an amendment and, in addition, an amendment pursuant to 37 CFR 1.48(a) would be required to correct the inventors named in the application. Any claims added to the application must be supported by the disclosure as filed and cannot add new matter.

## 37 CFR 1.48(d)

37 CFR 1.48(d) provides a procedure for adding the name of an inventor in a provisional application, where the name was originally omitted without deceptive intent. 37 CFR 1.48(d) does not require the verified statement of facts by the original inventor or inventors, the oath or declaration by each actual inventor in compliance with 37 CFR 1.63, or the consent of any assignee as required in 37 CFR 1.48(a). Instead, the procedure requires the filing of a petition identifying the name or names of the inventors to be added and including a statement that the name or names of the inventors were omitted through error without deceptive intention on the part of the actual inventor(s). The statement would be required to be verified if made by a person not registered to practice before the PTO. The statement could be signed by a registered practitioner of record in the application or acting in a representative capacity under 37 CFR 1.34(a). The petition fee set forth in 37 CFR 1.17(q) would also be required.

## 37 CFR 1.48(e)

37 CFR 1.48(e) provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application. Under 35 U.S.C. 119(e), as contained in Public Law 103-465, a later filed application under 35 U.S.C. 111(a) may claim priority benefits based on a copending provisional application so long as the applications have at least one inventor in common. An error in naming a person as an inventor in a provisional application would not require correction by deleting the erroneously named inventor from the provisional application since this would have no effect upon the ability of the provisional application to serve as a basis for a priority claim under 35 U.S.C. 119(e). However, 37 CFR 1.48(e) sets forth the requirements for deleting the name of a person erroneously named as an inventor in a provisional application. The procedure requires an amendment deleting the name of the person who was erroneously named accompanied by: a petition including a statement of facts verified by the person whose name is being deleted establishing that the error occurred without deceptive intention; the fee set forth in 37 CFR 1.17(q); and the written consent of any assignee.

## 201.04 Parent Application [R-1]

The term "parent" is applied to an earlier application of an inventor disclosing a given invention. Such invention may or may not be claimed in the first application. Benefit of the filing date of copending parent application may be claimed under 35 U.S.C. 120. >The term parent will not be used to describe a provisional application.<

## 201.04(a) Original Application [R-2]

"Original" is used in the patent statute and rules to refer to an application which is not a reissue application. An original application may be a \*first\* filing or a continuing application.

## 201.04(b) Provisional Application [R-3]

35 U.S.C. 111 Application.

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## (b) PROVISIONAL APPLICATION.—

(1) AUTHORIZATION.—A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include—

(A) a specification as prescribed by the first paragraph of section 112 of this title; and